

REMARKS

Claims 1-30 were originally filed in the present application.

Claims 1-30 are pending in the present application.

Claims 1-30 were rejected in the January 17, 2006, Office Action.

No claims have been allowed.

Claims 1-30 remain in the present application.

Reconsideration of the claims is respectfully requested.

Claims 1-30 were rejected as obvious over Bae *et al.* (US Pat. Pub 2003/0193964, "Bae") in view of Wentick *et al.* (US Pat. Pub. 2003/0231608, "Wentink"). These rejections are traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (*Fed. Cir.* 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir.* 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (*Fed. Cir.* 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir.* 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (*Fed. Cir.* 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir.* 1992); *In re*

Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

Claim 1 requires, among other limitations, that the “base station sends null frames on a forward traffic channel to said mobile station to verify that said forward traffic channel is reliable instead of sending a base station acknowledgment order to said mobile station to verify that said forward traffic channel is reliable”. Claim 13 similarly requires “sending null frames from said base station on a forward traffic channel to said mobile station to verify that said forward traffic channel is reliable instead of sending a base station acknowledgment order to said mobile station to verify that said forward traffic channel is reliable”. Claim 25 requires “said mobile station receives null frames on a forward traffic channel from said base station to verify that said forward traffic channel is reliable instead of receiving a base station acknowledgment order from said base station.”

As the Examiner admits, these limitations are not taught or suggested by Bae. Instead, Bae explicitly requires that “The BS transmits the BS Acknowledgement Order to the MS” (see, *e.g.*, 0035, 0044, 0046, 0062, and 0066). While Bae discusses null traffic data, at no point does Bae teach or suggest that the null data can be used instead of the BS Acknowledgement Order, which is required throughout Bae’s description. As is clear, Bae teaches directly away from the limitations of claim 1.

At this point in the rejection, the Examiner makes a cryptic reference to Wentink, stating “Wentink teaches a station acknowledges the frame by transmitting acknowledgement frame 608.” Frame 608 appears to be a transmission between two “Q-stations”, which appear to be independent stations on an 802.11 wireless LAN. This is not a message transmitted between a BS and an MS, and has no relation at all to the claimed invention. Wentink is drawn to an 802.11 WLAN, and has nothing to do with the wide-area wireless networks described in the present application and in Bae. As such, Wentink is not analogous art.

Further, even if teachings from Wentink could be applied to Bae, the teaching selected by the Examiner would appear to indicate that one mobile station could send an acknowledgement to another mobile station. This, of course, has nothing to do with the claimed sending of null frames on a forward traffic channel to a mobile station instead of sending a base station acknowledgment order to the mobile station. Since Wentink does not discuss base stations or wireless stations at all, there can be no relevant teaching, and the frame 608 referenced by the Examiner would appear to be, at best, additional signaling between two mobile stations.

Of course, there is also no proper motivation to combine the “signaling between Q-stations” teaching of Wentink’s WLAN with Bae’s wireless telecommunications system. As the Examiner is surely aware, the motivation to combine or modify must be specific to the actual teachings sought to be combined. “In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.” (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) emphasis added). “When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.” (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added).

The Examiner’s stated motivation, “to provide a method that each device in the network can continually monitor the quality of the media”, has nothing at all to do with the specific combination and modification suggested, even if it were possible or relevant.

Therefore, independent claims 1, 13, and 25, and dependent claims 2-12, 13-24, and 26-30 all distinguish over all art of record, and all rejections are traversed.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.


The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK BUTRUS, P.C.

Date: April 17, 2006

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@davismunck.com*



William A. Munck
Registration No. 39,308